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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,844	08/02/2001	Hiroshi Nitta	121.1018/HEW	5683
21171	7590	08/30/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			VAN BRAMER, JOHN W	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/919,844	Applicant(s) NITTA ET AL.	
	Examiner John Van Bramer	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-9, 12-15, 18, 19 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-9, 12-15, 18, 19, and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed June 26, 2006 cancelled claims 4, 5, 10, 11, 16, 17, 20, and 21. Claims 1, 7, 13, 19, and 22 have been amended. No new claims were added, thus the currently pending claims are Claims 1-3, 6-9, 12-15, 18, 19, and 22.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3, 7-9, 12-15, 19, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are:
 - a. Claims 1-3, 7-9, 12-15, 22 have been amended to include the limitation that a purchase information file, stores purchase information when a member utilizes the advertising information and that the information is then sent to the advertising company. However, nowhere in the body of the claims is an indication that a purchase can be made. The claims describe the generation of an image

displayed to a user containing the results of an inquiry and advertising information. The generation of a purchase and the capability of sending of purchase information has not been enabled in the body of the claim.

Additionally, the use of the term "aggregate" is indefinite. The applicant may be referring to the collective body of purchase information generated from a single transaction such as the employee number, purchase amount, quantity of purchase, and payment information, or the applicant may be referring to aggregating this information across a group of employees and sending the information in a batch file at the end of some specified time period.

- b. Claim 19 has been amended to include the limitation that confirmation information is stored and send to a second source. However, no step for generating a confirmation has been disclosed.

Claim Rejections - 35 USC § 102

- 4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 5. Claims 1-3, 6-9, 12-15, 18, 19, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Valentino (U.S. Patent Number: 4,648,037).

Claim 1: Valentino discloses an information inquiry apparatus that receives an information inquiry from a terminal connected through a communication pathway, comprising:

- a. An inquiry information file that stores the inquiry information for each member of an organization (Col 5, lines 12 – 22; and Col 6, lines 49 – 68)
- b. An advertisement information file that stores advertising information, possibly including an advertisement link that allows access to an additional advertising information, said advertising information being sent from an advertising company. (The employee benefits disclosed in Valentino include such items as retirement plans, health insurance plans, and flexible benefit plans such as a cafeteria plan. When an employee inquires as to the options available within such plans they are accessing a file that describes the various options from which an employee can choose. Therefore, they are accessing an information file that advertises the various options available to the employee) (Col 6, line 49 through Col 7, line 21)
- c. An inquiry image display generator that generates display data from the inquiry information file and the advertisement information file so that a display image of the display data contains the inquiry information for the member of the organization and the advertising information, possibly including the advertisement link that allows access to the additional advertising information. (Col 6, line 49 through Col 7, line 21)

- d. An inquiry information transmitter that receives the information inquiry from the terminal and transmits the inquiry image. (Col 6, line 49 through Col 7, line 21)
- e. A purchase information file that stores purchase information when the member utilizes the advertising information, the purchase information being sent in aggregate to the advertising company. (The purchase information file is the file containing the benefits and allocation amounts that the employee has elected within the benefit package. Such a file would contain information detailing the mutual funds selected by an employee participating in a defined contribution retirement plan or the options purchased in the cafeteria plan.) (Col 5, lines 49 – 64 and Col 14, lines 34 – 44)

Claim 2: Valentino discloses the information inquiry apparatus in claim 1, further comprising: a confirmation information file that stores confirmation information when the employee submits the information inquiry from the terminal and receives the display image. (Col 5, lines 49 – 64 and Col 14, lines 34 – 44)

Claim 3: Valentino discloses the information inquiry apparatus in claim 2, wherein the confirmation information is sent to the organization. (Col 5, lines 49 – 64 and Col 14, lines 34 – 44)

Claim 6: Valentino discloses the information inquiry apparatus in claim 1, wherein

the advertising information includes information tailored to at least one of an employee income level, an employee organizational unit and an employee information input. (Col 14, lines 45 – 65)

Claim 7: Valentino discloses an employee information communication method, comprising:

- a. Electronically storing employee information including at least one of employee name, employee company, employee number and employee password. (Col 5, lines 12 – 22; and Col 13, lines 52 – 67)
- b. Electronically storing advertising information from a first source. (Col 14, lines 2 – 18)
- c. Electronically storing employee detailed wage information including at least one of employee number, employee company, employee name, payment amounts, deduction amounts and date of payment from a second source. (Col 13, lines 52 – 67)
- d. Receiving an inquiry from an employee. (Col 14, lines 19 – 33)
- e. Generating a detailed wage image that includes advertising information, employee information and employee detailed wage information. (Col 14, lines 19 – 33)
- f. Electronically storing purchase information when an employee utilizes the advertising information. (Col 5, lines 49 – 64; and Col 14, lines 34 – 44)

- g. Sending in aggregate the purchase information to the first source. (Col 5, lines 49 – 64; and Col 14, lines 34 – 44)

Claim 8: Valentino discloses the employee information communication method in claim 7, further comprising electronically storing confirmation information when the employee submits the inquiry and receives the detailed wage image. (Col 5, lines 49 – 64; and Col 14, lines 34 – 44)

Claim 9: Valentino discloses the employee information communication method in claim 8, further comprising sending the confirmation information to the second source. (Col 5, lines 49 – 64; and Col 14, lines 34 – 44)

Claim 12: Valentino discloses the employee information communication method in claim 7, wherein the advertising information includes information tailored to at least one of an employee income level, an employee organizational unit and an employee information input. (Col 14, lines 45 – 65)

Claim 13: Valentino discloses an employee information communication system, comprising:

- a. A first electronic data storage device that stores employee information including at least one of employee name, employee company, employee

- number and employee password. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- b. A second electronic data storage device that stores advertising information from a first source. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
 - c. A third electronic data storage device that stores employee detailed wage information including at least one of employee number, employee company, employee name, payment amounts, deduction amounts and date of payment from a second source. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
 - d. An image generator that receives an inquiry from an employee and generates a detailed wage image that includes advertising information, employee information and employee detailed wage information. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
 - e. A fourth electronic data storage device that stores purchase information when an employee utilizes the advertising information, the purchase information being sent in aggregate to the first source. (Col 5, lines 49 – 64; and Col 14, lines 34 – 44)

Claim 14: Valentino discloses the employee information system in claim 13, further comprising a fourth electronic data storage device that stores confirmation

Art Unit: 3622

information when the employee submits the inquiry and receives the detailed wage image. (Col 5, lines 49 – 64: and Col 14, lines 34 – 44)

Claim 15: Valentino discloses the employee information system in claim 14, wherein the confirmation information is sent to the second source. (Col 5, lines 49 – 64: and Col 14, lines 34 – 44)

Claim 18: Valentino discloses the employee information apparatus in claim 13, wherein the advertising information includes information tailored to at least one of an employee income level, an employee organizational unit and an employee information input. (Col 14, lines 45 – 65)

Claim 19: Valentino discloses a wage information management apparatus, comprising:

- a. A detailed wage data structure that stores details of an employee's wage. (Col 5, line 66 through Col 6, line 10)
- b. A detailed wage inquiry authenticator that authenticates a wage inquiry based on an authentication code in the wage inquiry. (Col 6, lines 11 – 41)
- c. A communicator that, when the detailed wage authenticator authenticates the wage inquiry, sends the detailed wage data to a source of the wage inquiry. (Col 6, line 49 through Col 7, line 21)

- d. A deduction information collector that accepts a deduction information from the source of the wage inquiry. (Col 14, lines 19 – 44)
- e. A deduction information recorder that records the deduction information sent from the source of the wage inquiry. (Col 14, lines 19 – 44)
- f. A confirmation data structure that stores confirmation information, to be sent to a second source, when the source submits the wage inquiry and the communicator sends the detailed wage data. (Col 5, lines 49 – 64 and Col 14, lines 19 – 44)

Claim 22: Valentino discloses an employee information communication apparatus, comprising:

- a. A first electronic data structure that stores employee information including at least one of employee name, employee company, employee number and employee password. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- b. A second electronic data structure that stores advertising information from a first source. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- c. A third electronic data structure that stores employee detailed wage information including at least one of employee number, employee company, employee name, payment amounts, deduction amounts and date of payment

- from a second source. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- d. An image generator that receives an inquiry from an employee and generates a detailed wage image that includes advertising information, employee information and employee detailed wage information. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- e. A fourth electronic data storage device that stores purchase information when an employee utilizes the advertising information, the purchase information being sent in aggregate to the first source. (Col 5, lines 49 – 64; and Col 14, lines 34 – 44)

Response to Arguments

6. Applicant's arguments filed June 26, 2006 have been fully considered but they are not persuasive.
- a. The applicant argues that Valentino fails to teach sending purchase information, in aggregate to the advertising company. While the inclusion of an advertising company is a new limitation that has been added by the amendment and has been individually address in the preceeding rejections, the applicant is reminded that to complete the transactions disclosed in Valentino, aggregate information (employee identification, purchase amount, purchase price, and quantity) are inherently sent to the

company who operates the investments vehicles in which the employee elected to purchase.

- b. The applicant argues that Valentino makes no mention of storing confirmation information to be sent to a second source. Aside from the rejections detailed above, the Valentino reference discloses the printing of confirmations (Col 14, lines 34-44). The action of printing a confirmation inherently requires that the data be spooled in a memory buffer (storing) and sent to the printer (second source). Additionally, the act of printing inherently means that the data has been stored on paper and the purpose of a printed confirmation is to store the data incase a discrepancy occurs and correction of the discrepancy can be corrected only by supplying a second source with the printed confirmation.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action

is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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